

REMARKS

I. Introduction

Claims 7 and 13 to 18 are pending in the present application, with claims 15 to 18 being withdrawn from consideration. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 7, 13, and 14 Under 35 U.S.C. § 103(a)

Claims 7, 13, and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,245,789 (“Gray”), U.S. Patent No. 5,732,888 (“Maier et al.”), U.S. Patent No. 5,226,975 (“Denton et al.”), and U.S. Patent No. 6,592,947 (“McCane et al.”). It is respectfully submitted that the combination of Gray, Maier et al., Denton et al., and McCane et al. does not render unpatentable these claims for at least the following reasons.

The Final Office Action maintains the rejections as set forth in the Office Action of April 1, 2010. In this regard, **Applicants maintain all of the positions set forth in the “Response” submitted on June 17, 2010** regarding the deficiencies of the present rejection. Further, Applicants respectfully submit the following additional remarks concerning the “Response to Arguments” section beginning at page 6 of the Final Office Action.

At page 6 of the Final Office Action, the Examiner asserts that

Applicant cannot show or prove that all of the particles of the powder that fuse are out of the recited range [between 5 and 10 micrometers]. Examiner notes that it is possible for the particles to be within the recited range after it deforms and fuses to the surface and Applicant’s assertions against Examiner’s view is also speculation and conjecture.

Initially, the assertion that Applicants cannot show or prove that a reference does not include features of the present claims is entirely improper, since it is well-settled that the **initial burden of proof for establishing a prima facie case of obviousness is with the Examiner**. See M.P.E.P. §§ 2112–13; *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

As best understood by Applicants, the present rejection relies on a supposedly inherent feature of McCane. However, even if the assertion that “it is

possible for the particles to be within the recited range” were true—which is not conceded—there would still not be a sufficient showing to establish inherency. In this regard, it is well settled that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. As such, the present rejection is plainly deficient for at least this additional reason.

At page 7 of the Final Office Action, the Examiner further asserts:

With regard to Applicant’s arguments that Gray teaches away from having raised and recessed areas, Examiner likes to again reminded [sic] Applicant that the application of the coating of Meier et al onto the dome shaped rough surface of Gray would also permit improved prevention hydraulic [sic] sticking of the armature and pole piece surfaces of Gray and the height of the raised and recessed areas of Gray would increase to 10 μm as a result of Maier et al coating.

Initially, it is apparent that the Final Office Action continues to assert that applying a “coating thickness . . . generally measur[ing] between 10 and 25 μm ” would lead to a **height difference between raised and recessed areas** that is within the claimed range. However, Meier et al. does not disclose a thickness that varies within a given coating, much less a difference within the ranges claimed in the present application.

Moreover, the argument that the combination would somehow lead to a coating having a height difference between raised and recessed areas within the claimed ranges—which it does not—does not in any way address the fact that **Gray—which pertains specifically to a fuel injector—plainly teaches away** from any proposed modification of the surface roughness to have raised areas and recessed areas that are within the ranges claimed in claim 7 of the present application. As previously set forth in the Response submitted on June 17, 2010, in addition to unambiguously setting forth that the surface 63s of a core of a pole piece 62 should have a surface roughness rating value on the order of 0.4 μm to 0.8 μm , Gray also sets forth that ***“the surface 73s of the armature 73 can have a***

roughened surface texture over its entire surface area of a roughness average rating value of 8 to 12 microinches (0.20 to 0.30 micrometers) maximum

(emphasis added). Using the definition of the roughness rating disclosed in Gray, this would indicate a peak-to-valley average on the order of ***0.4 μ m to 0.6 μ m maximum***.

In view of the foregoing and the arguments set forth in the Response submitted on June 17, 2010, it is respectfully submitted that the combination of Gray, Maier et al., Denton et al., and McCane et al. does not render unpatentable claim 7 or either of claims 13 and 14, which depend from claim 7. Accordingly, withdrawal of this rejection is respectfully requested.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

/Clifford A. Ulrich/

Dated: October 26, 2010

By Clifford A. Ulrich (Reg. No. 42,194) for:
Gerard A. Messina (Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646